

REMARKS

The Examiner rejected claims 1, 2, 3, 8-20 and 23-28 under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the Examiner notes that claim 1 recites “a system”, while claiming limitations such as, “(b) play an audible message . . .” The Examiner claims that it is unclear whether the applicants are claiming a system or a method. The applicants respectfully disagree. However, the claims have been amended to more clearly recite “at least one computer readable medium operatively coupled with said processor and said data storage medium; said at least one computer readable medium” including software that is configured for specific claimed functions. The claims clearly read on a system and are believed to be in condition for allowance.

The Examiner rejected claims 1-3, 10-12, 15, 23, 24, 27, and 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,850,602 to Chou in view of U.S. Patent No. 4,764,949 to Faith, et al. Specifically, the examiner states that the Chou reference discloses a system as specifically claimed, but for the step of expressly playing a message that instructs a callee to terminate the call. The examiner notes that the Faith et al. reference teaches the playing of an audible message over the line that requests that a callee on the line terminate the call. The examiner further urges that the Faith et al. reference teaches the identification of whether or not the call has been terminated after the audible message is played by the system. The examiner suggests that it would have been obvious to a person of skill in the art to combine the teachings of these two references in order to derive a system as specifically claimed. The applicants respectfully disagree.

To establish a prima facie case of obviousness, three basic criteria must be met: First, the prior art reference (or references when combined) must teach or suggest all claim limitations. Second, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Finally, there must be a reasonable expectation of success. The teaching or suggestion to make the claim combination or combine the references and the reasonable expectation of success must both be found in the prior art and not based on the Applicant's disclosure. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

With regard to the first criteria, the cited references fail to teach or otherwise suggest all of the claim limitations. The Examiner urges that the Chou reference teaches software

that is configured to classify a number as being live answered if the is terminated in response to a message to the callee. This is not correct. The specification, especially, where indicated by the Examiner, (col. 8, line 62 ,to col. 9, line 67, and col. 6, lines 47-54) specifically teach the use of speech identification software to determine whether or not specific terms are spoken by the callee, or if a specific answering machine tone is detected. No software is provided to request the callee to terminate the call and no software is provided to determination if the call has been terminated, let alone determine if the call is live answered based on such data.

The Faith reference does teach the use of a message that prompts to the callee to terminate the call. However, no software is provided to determine whether or not the call was live answered based on the call being terminated specifically in response to the system requesting that the callee terminate the call. In any regard, the Faith reference fails to make up for the shortcomings of the Chou teachings.

With regard to the second criteria, for a suggestion or motivation to modify or combine references, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1368 (Fed. Cir. 2000). Courts and patent examiners should determine whether needs and problems known in the field **and addressed by the prior art references** can provide a reason for combining the elements **in the manner claimed**. KSR Intern. Co. v. Teleflex, Inc., No. 04-1350, 2007 WWL 1237837, at 4 (April 30, 2007). "In formulating a rejection under 35 USC § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements **in the manner claimed**." Memo on KSR Decision to Examiners issued by the United States Patent and Trademark Office, May 4, 2007. The prior art is not sufficient to establish obviousness without some objective reason to combine the teachings of the references. In re Kotzab, 217 F.3d 1368 (Fed. Cir. 2000), see also In re Sang Su Lee, 277 F.3d 1338 (Fed. Cir. 2002).

Claim 1 is a combination of elements not disclosed or otherwise suggested within the art. The specific limitations of a system that includes software configured to prompt a callee

to terminate the call and determine the type of callee that has been contacted based on whether or not the call was terminated in response to a specific request to do so is not found anywhere within the references. Nor has the Examiner identified the reason why a person of ordinary skill in the art would have combined the prior art elements in the specific structural manner claimed. It has not been shown how such a system would be within the knowledge of one of ordinary skill in the art. To be sure, the Examiner has not shown any allegation that such a system or the aforementioned software are known in the art, let alone shown that the claimed combination of elements would have been obvious to a person of skill in the art. Claim 1 is, therefore, believed to be allowable over the cited references for at least the aforementioned reasons. Claims 1-3, 10-12, 15, 23, 24, 27, and 28 each depend from claim 1 and are believed to be allowable for at least the reasons identified with respect to claim 1.

The Examiner rejected claims 1-3, 8, 9, 19, 20, 25 and 26, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0086541 to Brown et al. in view of the Faith et al. reference. Specifically, the Examiner states that the Brown et al. reference teaches a system as specifically set forth in the claims except for the teaching that a message be played to the callee that specifically requests that the call be terminated. Again, the Examiner offers the Faith et al. reference to support this teaching and states that it would have been obvious to a person of ordinary skill in the art to combine these references in order to derive the system as specifically claimed. The applicants respectfully disagree.

With regard to the first criteria in the obviousness-type analysis, the cited references fail to teach or otherwise suggest all of the claim limitations. The Examiner urges that the Brown reference teaches software that is configured to classify a number as being live answered if the is terminated in response to a message to the callee. This is not accurate. The Brown reference is using the term "terminated" to mean that a call from the system is answered, not that the line has gone off the hook to answer the call and then on the hook to terminate the call. To be sure, the specification, especially, where indicated by the Examiner, (paras. 0021, 0026, 0028, 0033-0035, and Table 2) all reference the use of voice recognition software to determine specific words or speech patterns used by a callee once the call is answered or "terminated". No software is provided to request the callee to terminate (end) the call and no software is provided to determination if the call has been terminated (ended), let alone determine if the call is live answered based on such data. The Faith reference does teach the use of a message that prompts to the callee to terminate the call. However, no

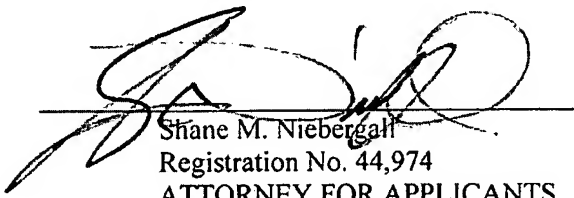
software is provided to determine whether or not the call was live answered based on the call being terminated specifically in response to the system requesting that the callee terminate the call. In any regard, the Faith reference fails to make up for the shortcomings of the Brown teachings. Claim 1 is therefore allowable over the cited references. Claims 2, 3, 8, 9, 19, 20, 25 and 26 each ultimately depend from claim 1 and are believed to be allowable for at least the reasons identified with respect to claim 1.

The examiner has rejected claims 13, 14, 16, 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over the Chou reference in further view of U.S. Patent No. 6,195,417 to Dans. The Examiner alleges that the Chou reference teaches the system as specifically claimed other than the limitation that the number is disconnected. However, the Examiner alleges that the Dans reference teaches that a system acknowledges and uses such limitations within its system. The Examiner states that it would have been obvious to combine these teachings in order to derive the system as specifically claimed. The applicants respectfully disagree. Claim 1 is believed to be allowable for at least the reasons identified hereinabove. The Dans reference fails to make up for the shortcomings of the Chou teachings. Claims 13, 14, 16 and 18 depend from claim 1 and are believed to be allowable for at least the reasons identified with respect to claim 1.

If an extension of time under 35 C.F.R. § 1.136 is required to obtain entry of this Amendment, such an extension is requested. If there are fees due under 37 U.S.C. §§ 1.16 or 1.17 which are not otherwise accounted for, please charge our Deposit Account No. 08-2623.

Respectfully submitted,

Date: June 18, 2008



Shane M. Niebergall  
Registration No. 44,974  
ATTORNEY FOR APPLICANTS  
HOLLAND & HART LLP  
555 17<sup>th</sup> Street, Suite 3200  
Post Office Box 8749  
Denver, Colorado 80201-8749  
Telephone: (303) 295-8034  
Facsimile: (303) 295-8261